

**REMARKS**

Claims 3, 6, 12, 14, 16, 18 and 19 have been amended based on the disclosure at, e.g., page 1, lines 13-28 of the present specification. Claim 20 corresponds to original claim 1 except for being a method claim. The basis for claim 21 can be found on page 10, line 30 to page 11, line 2. Claims 22-31 correspond to original claims 2-10 and 12 except for being method claims. Claims 32 and 33 correspond to original claim 2 except for being method claims. Claim 34 is a composition claim corresponding to a combination of previous claims 3, 6, and 16.

Entry of the above amendment is respectfully requested.

Applicants submit that claims 3, 6, 12, 14, 16, 18 and 19-33 are patentable over the cited art because the cited art neither teaches nor suggests the particular method recited in those claims.

Turning now to composition claim 34, Applicants have the following comments on the Advisory Action of March 15, 2011.

(1) With respect to the argument that the prior art does not teach or suggest the problem addressed by the present invention (pigment tends to remain when removing a photosensitive composition containing a pigment) and that a general method used to solve the problem is not known, the Examiner indicates out that the independent claims 3 and 19 are not directed to a method but to a composition.

On review, the Examiner's position appears to be directed to the discussion of the In re Omeprazole Patent Litigation case in the paragraph bridging pages 3-4 in the response filed March 3, 2011. However, as indicated at the beginning of that paragraph, the In re Omeprazole Patent Litigation case concerned a claimed product, just like the present claims concern a

product (a photosensitive composition remover). Since method-related discussion was used in connection with product claims in the *In re Omeprazole Patent Litigation* case, Applicants submit that it is appropriate to use method-related discussion in connection with the present claims. Accordingly, Applicants submit that the Examiner's position in the Advisory Action is inappropriate in this regard.

(2) With respect to the argument Examples 9-14 in Table 1 of the specification are within the scope of the claims, the examiner agrees. However, the Examiner indicates that there is no comparison of the composition of the instant application with the developer compositions of Kamayachi et al. and Koyanagi et al. (the closest prior art, which teach that the tetramethylbenzene may be used in a developer for a photosensitive composition).

In response, Applicants submit initially that as set forth in MPEP 716.02(e) III., "[a]lthough evidence of unexpected results must compare the claimed invention with the closest prior art, applicant is not required to compare the claimed invention with subject matter that does not exist in the prior art. *In re Geiger*, 815 F.2d 686, 689, 2 USPQ2d 1276, 1279 (Fed. Cir. 1987) (Newman, J., concurring)." In this regard, Applicants submit that none of the Examples in Kamayachi and Koyanagi disclose the use of tetramethylene, so Applicants do not need to test an embodiment containing tetramethylene to represent the prior art. Indeed, Applicants note that none of the Examples in Kamayachi and Koyanagi disclose the use of an aromatic hydrocarbon at all. Accordingly, Applicants submit that Wyatt's Example 4, which contains an aromatic hydrocarbon (albeit a C12-based aromatic hydrocarbon) represents the closest specific embodiment disclosed in the cited art.

Thus, Applicants submit that the present invention is not obvious over the cited art, and withdrawal of these rejections is respectfully requested.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: May 3, 2011

Respectfully submitted,



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